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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,096	02/14/2002	Keiichi Sato	033808/0282094	1424

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EXAMINER

SISSON, BRADLEY L

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/077,096

Applicant(s)

SATO ET AL.

Examiner

Bradley L. Sisson

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1, 2 and 4-11.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Bradley L. Sisson
Primary Examiner
Art Unit: 1634

Continuation of 2. NOTE: The response requests the cancellation of claims 2 and 8 yet claim 8 is presented in the replacement listing of all claims that are to be pending. The retention of claim 8 raises a new issue in that it would no longer be further limiting of claim 7, from which it depends. Additionally, the amendment to page 4, second paragraph, raises a new issue of new matter being introduced. While the response asserts at page 5, third paragraph, that the amendments are supported by the disclosure, no specific indication is made as to just where such support is to be found. See MPEP 2163.06 I.

Continuation of 5. does NOT place the application in condition for allowance because: Convincing evidence has not been made of record which renders moot the rejections of claims 1, 2, 4-11 under 35 USC 112, a failing to comply with the written description requirement; the rejection of claims 1, 2, and 4-11 under 35 USC 112, first paragraph, as failing to comply with the enablement requirement; and the rejection of claims 1, 2, and 4-11 under 35 USC 112, second paragraph.

At page 6, third paragraph, of the response received 13 February 2004, applicant asserts that the recitation "having exclusively freely mobile sample biopolymers therein" is both "obvious to one skilled in the art and [is] fully supported by the Declaration under 37 CFR 1.132. As such, no new matter was introduced via the claim recitation." The foregoing argument has been fully considered and has not been found persuasive towards the withdrawal of the rejection. As noted at page 2, last paragraph, bridging to page 3 of the Office action of 13 November 2003, one cannot rely upon obviousness to satisfy the written description requirement of 35 USC 112, first paragraph. *University of California v. Eli Lilly and Co.* (CAFC 1997) 43 USPQ2d at 1405, citing *Lockwood v. American Airlines Inc.* (CAFC 1997) 41 USPQ2d at 1966:

Recently, we held that a description which renders obvious a claimed invention is not sufficient to satisfy the written description requirement of that invention.

At page 6 of the response, argument is presented that the enablement requirement has been satisfied, directing attention to US Patent 6,013,372 A. It is noted with particularity that a review of the original disclosure fails to find where any document has been incorporated by reference. Further, a review of the original disclosure fails to find any reference to any US patent, much less any column and line thereof. While argument is also presented that certain specific materials could be used, it is noted that the claims are not so limited. Accordingly, applicant's arguments have not been found persuasive towards the withdrawal of the rejections.

At page 6, last paragraph, bridging to page 7 of the response, applicant asserts that the amendment to claims 1 and 7 overcomes the rejection of claims under 35 USC 112, second paragraph. As noted above, however, the response has not been entered and as such the issue remains.

The declaration under 37 CFR 1.132 filed 13 February 2004 is insufficient to overcome the rejection of claims 1, 2, and 4-11 based upon 35 USC 112, first paragraph, as failing to satisfy both the written description and enablement requirements; and the rejection of claims 1, 2, and 4-11 based upon 35 USC 112, second paragraph, as set forth in the last Office action because the facts presented are not germane to the rejections at issue. It is noted that the declarant is also a named co-inventor of the claimed invention. At page 1, third paragraph, of the Declaration it is stated: "It is my conclusion that the claimed recitation 'having exclusively freely mobile biopolymers therein' is fully supported by the inventor's Declaration under 37 CFR 1.132 as understood by one skilled in the art in view of the description pages 4-5." The foregoing conclusion improperly attempts to shift the burden of both enablement and written description from the originally filed application to a post-filing declaration. While a declaration may present evidence that the specification provides the requisite enablement and written description, one cannot rely upon a declaration to fulfill the omissions of the original disclosure. While applicant may assert that certain embodiments may be obvious to the skilled artisan, obviousness cannot be relied upon for satisfaction of the written description requirement. As noted in *University of Rochester v. G.D. Searle & Co., et al.* (CAFC 03-1304; February 13, 2004), each of the three elements of 35 USC 112, first paragraph, (enablement, written description, and best mode) are independent of one another and must all be met by the original disclosure.

At page 2, first paragraph, of the Declaration, attention is directed to "Japanese Patent No. 2756474, or corresponding U.S. Pat. No. 6,013,372 A, and EP Pat. No. 0816466 A (page 5, paragraph 3 of the specification)." A review of the disclosure finds that neither the corresponding US Patent nor EP Patent has been cited. Furthermore, not even the Japanese patent has been incorporated by reference. Rather, the specification only invites one to review the Japanese patent "for further detail" without ever citing any specific passage of the document. And while applicant now asserts that "column 10, line 41 to column 12 of the U.S. patent is especially relevant," such direction and guidance was not provided in the original disclosure and cannot be relied upon now to fulfill either best mode, written description, or enablement requirements under 35 USC 112, first paragraph.

At page 2, penultimate paragraph, the declaration states in pertinent part "we contend that no new matter is being introduced into the application through the submission of this response." The declaration bears only the signature of Keiichi Sato. Accordingly, the record seemingly indicates that declarant is making statements on behalf of another, which is not permitted (note use of "we," as compared to the singular personal pronoun "I").